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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,880	06/28/2000	Jeffrey Wheeler	95-427	6355

23164 7590 11/12/2004

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WASHINGTON, DC 200363307

EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/604,880

Applicant(s)

WHEELER ET AL.

Examiner

St. John Courtenay III

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6-28-00 & 4-14-03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119


- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

  
ST. JOHN COURTENAY III  
PRIMARY EXAMINER

## **Response to Request for Reconsideration**

Responsive to Applicant's arguments, the art rejections are withdrawn as set forth by the previous examiner. However, new grounds of rejection are set forth below:

Obviousness-type double patenting Rejection:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

"Double patenting rejection of application claims was fully justified where applicant, in course of expanding first application to disclose enough more by way of details, alternatives, and additional uses to support broad, dominating, generic claims in later applications, has disclosed no additional invention or discovery other than that what was already claimed in patent on first application; there is significant difference between justifying broadening of claims and disclosing additional inventions." In re Van Ornum, 214 USPQ 761 (CCPA 1982).

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 27 of co-pending parent application 09/778,773, now U.S. Patent 6,738,781 (Mustoe et al.).

Although the conflicting claims are not identical, they are not patentably distinct from each other because of corresponding

language that recites virtually all of the same elements and functions claimed in the previously patented invention, e.g., "A method in a processor-based system configured for executing a plurality of management programs according to respective **command** formats", "validating a generic command", "a command parse tree," etc.

The claimed differences would be obvious to a programmer of ordinary skill because the instant claims are merely broader and/or alternate variations of the claims recited in the co-pending application.

For example, independent claim 1 of the instant application more broadly and/or alternately claims:

"A method in a processor-based system configured for executing a plurality of management programs according to respective **command** formats, the method comprising: receiving a generic command from the user; validating the generic command based on a command parse tree that specifies valid generic commands relative to a prescribed generic command format, the command parse tree having elements each specifying at least one corresponding generic command component and a corresponding at least one command action value, the validating step including identifying one of the elements a best match relative to the generic command; and, issuing a prescribed command of a selected one of the management programs according to the corresponding format, based on the identified one element."

In contrast, claim 1 of the co-pending application (U.S. Patent 6,738,781) more narrowly and/or alternately claims:

"1. A method in a processor-based system configured for executing a plurality of management programs according to respective **command** formats, the method comprising: receiving from a user an input word representing at least a portion of a **generic command**; determining whether the input word is a new **command** word relative to a character-based **command parse tree** configured for identifying known **command** words; selectively adding the input word to the character-based **command parse tree** based on determining that the input word is a new **command** word; **validating the generic command** following the selectively adding step; and issuing a prescribed **command** of a selected one of the management programs according to the corresponding **command** format, based on **validating the generic command**; wherein the determining step includes: comparing a first character of the input word with a

group of first character elements at a root level of the character-based **command parse tree**, the first character elements including respective initial characters of the known **command** words; successively traversing to a linked character element in an adjacent level of the character-based **command parse tree** based on a corresponding match between a corresponding character of the input word and a corresponding matched character element of the character-based **command parse tree**; and identifying the input word as a new **command** word based on a determined absence of a match for one character of the input word relative to the linked character elements."

Because the instant claims merely eliminate and/or alternately claim limitations from the set of elements and functions claimed in the parent application, such modifications would be readily apparent to a programmer of ordinary skill.

#### **Terminal Disclaimer**

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

For post GATT applications, (i.e., applications filed after June 8, 1995), the rule § 1.321 (4) (c) (3) requires a provision that must be included. The following requirement is UNCHANGED by GATT and therefore a terminal disclaimer is required for the instant application, i.e., *"shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection."*

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**Prior Art not relied upon:**

Please refer to the references listed on the attached PTO-892 which are not relied upon in the claim rejections detailed above.

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**How to Contact the Examiner:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to St. John Courtenay III, J.D., M.B.A., whose telephone number is 571-272-3761. A voice mail service is also available at this number. The Examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-AI who can be reached on 703-305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**All responses sent by U.S. Mail should be mailed to:**

Commissioner for Patents  
PO Box 1450  
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**Patent Customers advised to FAX communications to the USPTO**

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faxnotice.pdf>

Effective Oct. 15, 2003, ALL patent application correspondence transmitted by FAX must be directed to the new PTO central FAX number:

**NEW PTO CENTRAL FAX NUMBER:**

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**703-872-9306**

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900.**

**Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:**

**Technical Center 2100 CUSTOMER SERVICE: 703 306-5631**

The Manual of Patent Examining Procedure (MPEP) is available online at:  
<http://www.uspto.gov/web/offices/pac/mpep/index.html>



ST. JOHN COURTENAY III  
PRIMARY EXAMINER



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